



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants: Christopher A. Wiklof, Cathy Aragon, Josh M. Kornfeld, Clarence T. Tegreene, and Jim T. Russell

Serial No.: 10/007,784

Title: SCANNER AND METHOD FOR SWEEPING A BEAM ACROSS A TARGET

Filing Date: November 13, 2001

Examiner/Unit: Denise S. Allen / 2872

Attorney Docket No.: 1788-22-3

CERTIFICATE OF MAILING OR TRANSMISSION

I hereby certify that this correspondence is being deposited in the United States Postal Service as First Class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this 6th day of September, 2005.

Kelly Redusen
Signature

RESPONSE TO RESTRICTION REQUIREMENT UNDER 37 CFR § 1.143

TO THE COMMISSIONER FOR PATENTS:

In response to the August 5, 2005 restriction requirement under 35 USC § 121, Applicants elect Group II (claims 7-20, 25-30, 32, and 36-44) for prosecution with traverse.

The Applicants' attorney thanks the Examiner for speaking with him on August 26, 2005.

At the Examiner's request, the Applicants' attorney has divided the claims into two groups, Group I and Group II, which correspond to the claimed species identified by the Examiner. The Group I claims, which read on the first species, recite a single magnetic

force, and the Group II claims, which read on the second species, recite two magnetic forces.

Group I claims: 1-6, 21-24, 31, and 33-35.

Group II claims: 7-20, 25-30, 32, and 36-44.

The Applicants' attorney, however, believes that the restriction is improper for the following reasons, and, therefore, requests that the Examiner withdraw the restriction and examine all of the claims together.

According to MPEP § 803, if the Examiner can search and examine the application without serious burden, then he/she **MUST** examine the application on the merits even though it includes claims to independent or distinct inventions. As discussed below, because claims 1 – 44 recite related subject matter, the Examiner can perform a single search and examination that will cover all of the claims. Consequently, the Examiner can search and examine the application without serious burden, and, therefore, **MUST** examine all of the claims 1 – 44 together.

Because the Group I claims are generic to both the first and second species, a search and examination of the Group II claims will also cover the Group I claims. Claim 1 recites activating a beam-reflector assembly with a first magnetic force (limitation 1). Group II claim 10 recites a limitation similar to limitation 1, and also recites retaining a mirror of a beam-reflector assembly in a home position with a second magnetic force (limitation 2). Therefore, claim 1 is broad enough to cover, and thus is generic to, both the first and second species. Because claims 21 and 33 each recite a limitation that is similar to limitation 1, claims 21 and 33 are also generic to both the first and second species. During her search and examination of the Group II claims, the Examiner will be looking for references that teach or suggest both the limitations 1 and 2. Therefore, because the Group I claims also each include limitation 1 or a similar limitation, the search for the Group II claims will inherently cover the Group I claims. And if the Examiner finds such references, she will apply them to the Group II claims by indicating how the references teach or suggest limitations 1 and 2 or similar limitations. Therefore, because the Group I claims also each include limitation 1 or a similar limitation, the examination of the Group II claims will inherently cover the Group I claims. Consequently, because a single search

and examination will cover all of the Group I and Group II claims 1-44, the Examiner can search and examine the Group I and Group II claims together without serious burden, and thus must examiner claims 1-44 together.

Furthermore, as discussed with the Examiner, the Applicants' attorney added many of the pending claims in response to a series of improper §112 rejections that the former Examiner imposed in a series of four non-final Office Actions before this restriction requirement. The Applicants' attorney added these new claims in an attempt to persuade the former Examiner to remove the improper §112 rejections for at least the new claims while he preserved the right to appeal these rejections for the other claims. Therefore, it is unfair to now reduce the number of pending claims by restriction when this number is due to improper rejections by the former Examiner.

In the event additional fees are due as a result of this amendment, payment for those fees has been enclosed in the form of a check. Should further payment be required to cover such fees you are hereby authorized to charge such payment to Deposit Account No. 07-1897.

If the Examiner believes that a phone interview would be helpful, he is respectfully requested to contact the Applicants' attorney, Bryan Santarelli, at (425) 455-5575.

DATED this 6th day of September, 2005.

Respectfully submitted,

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